

REMARKS/ARGUMENTS

Claims 1-91 are pending in the application. Claims 1-48 and 91 are rejected under 35 U.S.C. 101 as directed to non-statutory subject matter; claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90 are rejected as anticipated under 35 U.S.C. 102(a); and claims 1-91 are rejected as obvious under 35 U.S.C. 103(a). The rejections are traversed and reconsideration is requested.

Claim Rejections - 35 U.S.C. § 101

Claims 1-48 and 91 stand rejected because the examiner considers the claimed invention is directed to non-statutory subject matter in that the examiner considers that “technology” is required in the body of the claim. However, as recently pointed out by the Board of Patent Appeals and Interferences in *Ex Parte Lundgren*, BPAI, No. 2003-2088, 9/28/05, the test for patentable subject matter under 35 U.S.C 101 does not include a separate “technological arts” test. Accordingly, the examiner’s application of a separate “technological arts” test to the patentable subject matter requirement of Section 101 is incorrect and the rejection should be withdrawn.

Claim Rejections - 35 U.S.C. § 102

Claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90 are rejected as anticipated under 35 U.S.C. 102(a) by Minton (U.S. 6,014,643). The examiner contends that claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90 are anticipated by Minton—somewhere, presumably in the fifteen columns of text and seven figures of Minton—and official notice “as to any limitation of the cited claims not directly taught by Minton” which the examiner contends “are inherent to prior art system as a whole”. According to the examiner, Minton “is directed to a method and apparatus for trading financial instruments” and that “many regularly traded financial instruments, such as preferred stocks and vanilla options” are “securities inherent in the teaching of Minton”. However, the examiner does not set forth findings in support of such rejection. Inasmuch as the examiner fails to specify what limitations of claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90 are anticipated by Minton, it is impossible to know the “limitation of the cited claims not directly taught by Minton” of which the examiner purports to take

“official notice”. Accordingly, the examiner has failed to establish a *prima facie* case of anticipation of claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90.

Moreover, instead of method and system for investing in one or more customizable investment products, as recited in claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90, Minton teaches nothing more than a trading system that allows individual user’s at their respective desktops to buy and sell publicly traded securities direct from one another over a public network thereby avoiding brokers’ spreads and commissions. See, e.g., Minton, Col 1, line 15-Col 3, line 16. Consequently, Minton fails to disclose or even suggest the required combination of limitations of independent claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90. Because each and every element as set forth in claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90 is not found, either expressly or inherently in Minton, the Examiner has failed to establish the required *prima facie* case of unpatentability. See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628 (Fed. Cir. 1987); See also MPEP §2131.

Claim Rejections - 35 U.S.C. § 103

Claims 1-91 are rejected under 35 U.S.C. 103 as obvious over Minton (U.S. 6,014,643) in view of Pr News Wire, CBOE Begins Trading Index Linked Principal Protected Notes. As noted above with respect to the rejection under 35 U.S.C. 102 however, the examiner fails to specify what limitations of claims 1-4, 7, 8, 23-30, 34-49, 52, 53, 68-75, and 79-90 are anticipated by Minton, so it is impossible to know the “limitation of the cited claims not directly taught by Minton” of which the examiner purports to take “official notice”. Moreover, asserting that Minton fails to teach certain limitations found, for example, in eight of the ninety-one claims in the application, the examiner asserts only that Pr News Wire, CBOE Begins Trading Index Linked Principal Protected Notes teaches that “the CBOE has been trading Principal Protected Equity Linked Notes as of 1998” and it would have been obvious “to have modified the system of Minton to handle the Notes of the secondary reference”. The examiner fails to specify what limitations of Minton it would have been obvious to modify and does not set forth findings in support of such rejection, and accordingly, the examiner has failed to establish a *prima facie* case of unpatentability of claims 1-91.

Further, instead of method and system for investing in one or more customizable investment products, as recited in claims 1-91, Minton teaches nothing more than a trading system that allows individual user's at their respective desktops to buy and sell publicly traded securities direct from one another over a public network thereby avoiding brokers' spreads and commissions. See, e.g., Minton, Col 1, line 15-Col 3, line 16. Pr News Wire, CBOE Begins Trading Index Linked Principal Protected Notes, which merely announced commencement of trading in 1998 of non-interest bearing notes entitling holders at maturity to receive the note principal plus an amount based on percentage increase in the S&P 500 Index, fails to remedy the deficiencies of Minton.

Consequently, Minton and/or Pr News Wire, CBOE Begins Trading Index Linked Principal Protected Notes, either alone or in combination with one another, fail to disclose or even suggest the required combinations of limitations recited in claims 1-91. Because the cited references, either alone or in combination, do not teach the limitations of claims 1-91, the examiner has failed to establish a *prima facie* case of unpatentability. See In re Royka, 490 F.2d 981, 985 (C.C.P.A., 1974) (holding that a *prima facie* case of obviousness requires the references to teach all of the limitations of the rejected claims; See also MPEP §2143.03.

Examiner's Requirement for Information - 37 C.F.R.. § 1.105

“8. The information is required to identify products and services embodying the disclosed subject matter of trading principal protected notes and identify the properties of similar products and services found on the prior art. In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.”

Reply: The employment relationship between the inventor and the assignee that existed as of the priority filing date(s) claimed for the present application no longer exists and based on information deemed by the undersigned attorney of record to be reasonably and readily available, upon information and belief the undersigned attorney of record responds that no products or services incorporated the claimed subject matter as of the priority filing date of this application. See, e.g., 37 C.F.R. 1.105(a)(vii).

“9. In response to this requirement, please provide the names of any products or services that have incorporated the disclosed prior art trading of principal protected notes, CybicBulls, CybicBears, CybicProtects, CybicFunds, CyubicSecure [sic] and other similar products.”

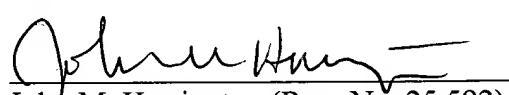
Reply: As previously noted, the employment relationship between the inventor and the assignee that existed as of the priority filing date(s) claimed for the present application no longer exists and based on information deemed reasonably and readily available, upon information and belief the undersigned attorney of record responds that, as set forth in the present application, the terms CybicBulls, CybicBears, CybicProtects, CybicFunds, CybicSecure are names invented and proposed for the customized retail investment contracts according to embodiments of the invention which have not “incorporated the disclosed prior art” identified by the examiner; and that the term “principal protected notes” used by the examiner in framing the question is not found in the specification or claims of the present application and is not defined by the examiner but is presumed to refer to the non-interest bearing notes entitling holders at maturity to receive the note principal plus an amount based on percentage increase in the S&P 500 Index identified in Pr News Wire, CBOE Begins Trading Index Linked Principal Protected Notes cited by the examiner, which did not incorporate the claimed subject matter.

Conclusion

In view of the foregoing amendment and these remarks, each of the claims remaining in the application is in condition for immediate allowance. Accordingly, the examiner is requested to reconsider and withdraw the rejection and to pass the application to issue. The examiner is respectfully invited to telephone the undersigned at (336) 607-7318 to discuss any questions relating to the application.

Respectfully submitted,

Date: 10/31/05


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